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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,152	04/12/2004	Philip A. Carpino	PC25808A	4558
28523	7590	10/20/2006	EXAMINER	
PFIZER INC. PATENT DEPARTMENT, MS8260-1611 EASTERN POINT ROAD GROTON, CT 06340			OWENS, AMELIA A	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/823,152

Applicant(s)

CARPINO ET AL.

Examiner

Amelia A. Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 7/27/2006
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-11, 30, 31, 34-36, 42, 43, 49, 55, 59, 64, 65, 69, 72 and 73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 7-11, 30, 31, 34-36, 42, 43, 49, 55, 59 and 64 is/are allowed.
- 6) ☐ Claim(s) 60, 65, 69, 72, 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Claims 1-4,7-11,30,31,34-36,42,43,49,55,59,60,64,65,69,72,73 are pending.
2. Claims 61-63,66-68,70-71 were canceled in the amendment/response filed October 28, 2005. It is noted these claims are present in the current claim list.
3. The status identifier for claims 59,60,64,65,69,72,73 is listed as 'withdrawn' and should be 'previously presented'.
4. Applicants are requested to provide a correct copy of the claims.

### *Claim Rejections - 35 USC § 112*

5. The rejection of claim 1 under 35 USC 112, 1<sup>st</sup> paragraph regarding term prodrug is dropped. The claim has been amended.
6. Claims 60,65,69,72,73 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Firstly, the examiner notes that claim 70,71 (previously canceled), and claim 64 were erroneously included in the rejection. Secondly, the examiner is rejecting claims 60,65,69,72,73. Thirdly, the listing of terms is present in rejected claims 60,65,69. Claims 72,73 are included as these claims depend from claim 69 and therefore incorporate the terms.

Applicant's remarks have been considered but are not persuasive. Anti-obesity agents were the only agents argued as the amendment of October 28,2005 limited the claims to additional antiobesity agents. The other agents are no longer present in the claims. See claim 60 filed with the amendment dated 10/28/2005.

For example, the claims/specification lists PYY3-36 or an analog thereof. For support applicants cite USSN 2002/0141985 (10/016969). This application has been rejected as non-enabling for PPY3-36 analogs. The examiner was unable to get a copy of WO 03/027637. Thus the specification fails to provide written description for PPY3-36 analogs. Arguably, even if a pharmacist were not necessarily one of ordinary skill in the art of drug development, in light of the above where would a pharmaceutical chemist or physician find a PPY3-36 analog? While drugs may be listed by their mechanism of action, where have PYY3-36 been listed to have an antiobesity mechanistic action. Applicants cite a book. The examiner does not have a copy of this book. Pages listing PYY3-36 analogs have antiobesity activity have not been provided. The

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specification must meet the requirements of 35 USC 112, at the time of filing and it is not seen where PPY3-36 analogs are adequately described herein.

7. Claims remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

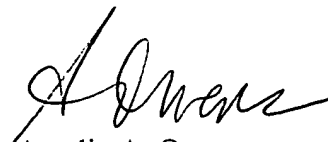
Applicants remarks have been considered but re not persuasive in view of above.

8. Claims 1(as presentd 7/27/06 with prodrug deleted) and 2-4,7-11,30,31,34-36,42,43,49,55,59,64 (as presented in the 10/28/2005) are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Amelia A. Owens  
Primary Examiner  
Art Unit 1625